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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,621	07/17/2003	Ruediger Tushaus	DORSTENER-001CIP	1876
26604	7590	03/24/2004	EXAMINER	
KENNETH L. NASH P.O. BOX 680106 HOUSTON, TX 77268-0106			POPOVICS, ROBERT J	
			ART UNIT	PAPER NUMBER
			1724	
DATE MAILED: 03/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/621,621	Applicant(s) TUSHAUS ET AL.	
	Examiner Robert J. Popovics	Art Unit 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-15 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/4/04</u> + <u>10/31/03</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-8 and 13-19, drawn to a Screen Assembly, classified in class 210, subclass 499.
- II. Claims 9-12, drawn to a Method for Mounting Vibrational Filters, classified in class 29, subclass 896.62.

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed could be used in a materially different process of using that product, such as, the claimed article could be used as a support surface, or as a window shade, or room partition.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and vice versa, restriction for examination purposes as indicated is proper.

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This application contains claims directed to the following patentably distinct species of the claimed invention:

Weave Species	Weave
1	Plain Weave
2	Three Heddle Weave
3	Five Heddle Weave

First Wire Shape Species	As Identified in Figure 4
1	30
2	32
3	34
4	36
5	45

Second Wire Shape Species	As Identified in Figure 4
1	30
2	32
3	34
4	36
5	45

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each genus as set forth above, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently

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added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Kenneth L. Nash, on March 17, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8 and 13-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Mr. Nash elected the following:

- Weave Species number 3. Presently, all claims are generic to the elected weave species.

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- First Wire Shape Species number 4 (rectangular), and identified claims 1-7 and 13-19 as reading on the elected First Wire species, with claims 1-7 and 13-19, being generic to the First Wire species.
- Second Wire Shape Species number 4 (rectangular), and identified claims 1-6,13-15,17-19 as reading on the elected Second Wire species, with claims 1-6,13-15,17-19, being generic to the Second Wire species.

Accordingly, claims 1-6,13-15 and 17-19 shall be examined, said claims reading on each of the elected species, or being generic thereto. Claims 7,8 and 16 are excluded as a result of the Second Wire Shape Species election, while claim 8 is excluded by virtue of the First Wire Shape Species election.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,13-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combine teachings of AAPA (Applicant's Admitted Prior Art) and Audino (US 2,423,923) and Leone (US 5,598,930).

Audino discloses a screen employing a rectangular shaped wire illustrated in Fig. 3 – wire 14. The intersections of the screen of Audino are not taught to be welded, as recited in claims 1 and 13.

Claim 2 additionally differs from Audino, by specifying, “ at least one relatively finer filtering screen secured with respect to a surface of said first screen,” while claim 13 additionally differs, in that it specifies, “at least one additional screen mounted to said first surface of said first screen and secured thereto.”

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AAPA teaches: (Emphasis added by Examiner)

Vibratory and/or filtering screens are well known in the art and may be used for various filtering purpose such as, for instance, for filtering fluids, solids, and/or separating particles from fluids. For instance, vibratory screens are commonly utilized during mining or drilling operations. During drilling operations, drilling fluid is typically pumped into the drill pipe, through the drill bit, and then back to the surface in the annulus between the drill pipe and the wellbore. The drilling fluid performs numerous important functions, one of which is to remove the drilling cuttings, formation materials, and debris from the wellbore. The drilling fluid is quite expensive and therefore it is desirable to filter the wellbore materials from the drilling fluid so the same drilling fluid can be used repeatedly. Thus, the drilling fluid is typically continuously circulated through the wellbore as the well is drilled whereby a continuous vibratory screening process is normally utilized to clean the drilling fluid.

[0003] A vibrating screen or shaker may be utilized for filtering the drilling fluid and may typically be positioned between the flow of drilling fluid from the wellbore and the pumps. There may be several different filters operating to filter the different size particles, cuttings, materials, and so forth. In many cases, there may be different layers of vibrating screening material. One or more layers of finer materials for filtering finer particles may be supported or backed by a stronger, typically coarser, filament mesh or cloth so the fine material is better able to withstand to vibrational forces and the weight of the fluid over longer periods of time.

Audino discloses a screen material employing flattened members (e.g., 14 in Fig. 3), which are used in order to “make it readily bendable” (col. 1, lines 25-30). In view of the teaching of Audino, it would have been obvious to one of ordinary skill in the art to employ planar surfaced wires in the well known devices AAPA discloses above, in order to more easily shape the resultant screens and/or manufacture the apparatus disclosed by AAPA.

Leone (US 5,598,930) discloses the welding of vibratory screens at column 2, lines 30-50. In view of the teaching of Leone, it would have been obvious to one of ordinary skill in the art to employ welding techniques when manufacturing the well known devices AAPA as modified in view of Audino above, in order to secure the screen surfaces.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

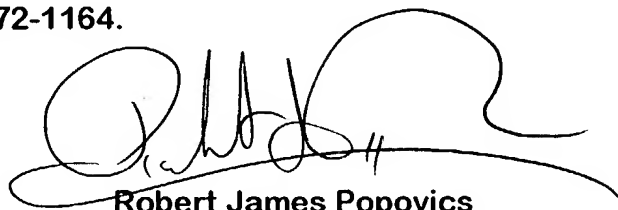
Claims 1-6,13-15 and 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/157,537 in view of Leone (US 5,598,930). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6,13-15 and 17-19 specify the screens to be welded.

Leone (US 5,598,930) discloses the welding of vibratory screens at column 2, lines 30-50. In view of the teaching of Leone, it would have been obvious to one of ordinary skill in the art to employ welding techniques when manufacturing the screen recited in claims 1-21 of 10/157,537, in order to secure the screen surfaces.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication should be directed to Robert J. Popovics at telephone number (571) 272-1164.

A handwritten signature in black ink, appearing to read 'R. J. Popovics', with a large, sweeping flourish extending from the end of the signature.

Robert James Popovics
Primary Examiner
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March 16, 2004